

REMARKS

The last Office Action dated April 6, 2004 has been carefully considered.

It is noted that Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hiraku (U.S. Pat. No. 6,047,684).

It is noted that claims 1, 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kono (U.S. Pat. No. 5,775,304).

It is noted that Claims 2-4 are rejected under 35 U.S.C. § 103 as being unpatentable over Kono (U.S. Pat. No. 5,775,304) in view of Sufferedini (U.S. Pat. No. 6,488,012).

It is noted that Claims 5-7 are rejected under 35 U.S.C. § 103 as being unpatentable over Kono (U.S. Pat. No. 5,775,304) in view of Yamada (U.S. Pat. No. 4,827,897).

It is noted that Claims 10-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Kono (U.S. Pat. No. 5,775,304) in view of Wright (U.S. Pat. No. 5,507,266).

It is noted that Claims 12-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Kono (U.S. Pat. No. 5,775,304) in view of Yamada (U.S. Pat. No. 4,827,897).

Applicant believes that Hiraku and Kono teach much more complex inventions than the invention of the present application, by focusing on complex embodiments such as that claimed in the Hiraku and Kono patents. Thus, applicant believes that Kono and Hiraku teach away from the simplicity of the present invention, which provides a solution to the problem of increasing the fuel pressure in an existing motor with a minimum of manufacturing steps and without changing or modifying existing electronics of the motor. See *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) (prior art reference "appears to teach away from the selection of" the claimed composition "by focusing on more complex examples"). The fact that a simple solution has escaped other workers in the art is some evidence that it was not obvious to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136

USPQ 220 (CCPA 1963):

Appellant's claimed invention departs from the prior art in the direction of simplicity rather than in the direction of complexity. . . . The simplicity of this useful invention is, in retrospect, some evidence that it was not obvious to a person of ordinary skill in the art In re Osplack, 39 CCPA 932, 195 F.2d 921, 93 USPQ 306. . . . While it is admittedly simple, it has escaped the other workers in this crowded art. We do not think the simplicity of appellant's construction should deprive him of his right to a patent thereon. Expanded Metal Co. v. Bradford, 214 U.S. 366.

Kono and Hiraku patents teach an engine having a closed loop system such that the electronic controller of the system senses engine parameters, performs calculations and determines the proper injection quantity of fuel to the engine.

Amended claims 1, 3 , 7-8, 10 and new claims 14, and 15 claims a pumping device or booster pump which is controlled by a user selected engine parameter. This system is added to a preexisting engine having a fuel pump and possibly an electronic controller which adjusts fuel pressure as engine parameters change. The claimed invention is added to this existing engine to increase the fuel pressure to, in one embodiment, a fuel injector at pressures higher than the existing electronic controller would calculate. The user determines, not an electronic controller, what engine parameter the invention senses to increase the pressure. Furthermore, the invention allows the user to increase the fuel pressure to the injector allowing more fuel to flow, thereby increasing delivery of fuel to the engine and increasing resulting horsepower beyond what the existing could support.

Applicant believes, therefore that Kono and Hiraku teaches away from allowing the user to select the engine parameter used to increase fuel pressure to an existing system. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Therefore it is respectfully submitted that Kono and Hiraku is not relevant to the

present invention.

In view of the Examiner's rejection of the claims over the art, Applicant has added Claims 14 and 15 to further include the limitations and clarification to overcome the prior art.

It is respectfully submitted that the amended and new claims 14 and 15 clearly and patentably distinguish over the prior art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references. Applicant believes that combining the references discussed above would not lead to the claimed invention, in that the present invention does not merely employ the known substitution of equivalents but rather employs a new, non-obvious combination to accomplish the objectives set out in the present application.

As for the proposed combination of references cited by the examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined now in the amended and new claims 14 and 15, any hypothetical construction produced by this combination would not lead to applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the new claims 14 and 15 and should be withdrawn. The new claims 1-15 should be considered as patentably distinguishing over the art and should be allowed.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this

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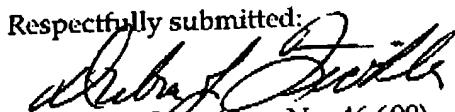
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would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:



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